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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/624,246	07/24/2000	Paul Clarke	1131-0444P	6209

7590

11/20/2002

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EXAMINER

LOPEZ, CARLOS N

ART UNIT

PAPER NUMBER

1731

DATE MAILED: 11/20/2002

10

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-16

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/624,246	CLARKE ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Carlos Lopez	1731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 May 2002.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16, 21 and 22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16, 21-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other:  |

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## **DETAILED ACTION**

### ***Response to Amendment***

The amendment filed on 5/22/02 has been entered as Paper No.9. The rejections made under 35 U.S.C 112, second paragraph, to claims 1-16 and 21-22 is withdrawn. The PTO-892 that was mailed on 2/27/02 incorrectly cited the country of Otto 3403281 as Great Britain rather than Germany, this error had been corrected by a pen-and-ink change to the USPTO application file.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**1)** Claims 1, 4-12, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Otto (DE 3403281). Otto discloses a filter assembly comprising a cylindrical filtering core (14); a tubular filter sheath (22) surrounding said core and between said core and sheath, passages spaced circumferentially around said core and extending continuously between the two ends of the filter assembly and tipping paper (24) (Figure 1). As for claim 4, Otto discloses means for introducing air into the passages, perforations 26. As for claims 5 and 8, the core comprises a plurality longitudinal grooves at the outer peripheral surface thereof, defining said passages with the inner peripheral surface of said sheath (22). As for claims 6, 9, 11, and 12, the grooves are provided by a corrugated wrapper (20) between the filter core and sheath. As for claims 7 and 10, the

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sheath (22) is porous (Page 8, lines 5-10). As disclosed above Otto anticipates the above claims

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2) Claims 2-3, 14, 15, and 21 are rejected under 35 U.S.C. 103(a) as obvious over Otto (DE 3403281). Otto is silent disclosing the thickness of the sheath, the ratio of the sheath thickness to the diameter of the core and the total cross-sectional area of the passages. However, the claimed parameters are known variables in the tobacco art that affect the overall ventilation of a filter and/or removal efficiency of the filter. Hence, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify known parameters in the tobacco art to obtain the desired filter ventilation or removal efficiency.

As for claim 21, the number of passages would depend on the desired ventilation.

As for claim 15, a second filter tip 12 as disclosed by Otto, aligned with the filter assembly. While Otto is silent disclosing the airflow resistance of said tip, it is assumed absent any indication that the tip has conventional airflow resistance such as claimed by applicant.

Applicant is referred to Table 1, of Morifuji et al (US 4,488,563) discloses the claimed airflow resistance to show conventional airflow resistance of tobacco.

The indicated allowability of claim 13 is withdrawn in view of the newly discovered reference(s) to Gonterman (US 4,649,943). Rejections based on the newly cited reference(s) follow.

**3)** Claims 13 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Otto (DE 3403281) in view of Gonterman (US 4,649,943). Otto is silent disclosing openings on the tubular corrugated element (20). However, Gonterman teaches of having perforations of the corrugated wrapper forming the passages on the circumference of the filter core in order to provide an even dilution of the smoke being inhaled by the smoker (Bridging paragraph of Columns 3 and 4). At the time invention was made, it would have been obvious to a person of ordinary skill in the art to have made perforations on Otto's corrugated paper as taught by Gonterman to improve even dilution of the inhaled smoke.

### ***Response to Arguments***

Applicant's arguments filed 5/22/02 have been fully considered but they are not persuasive. Applicant argues that the paper wrapping (22) can't be considered a sheath in the usual sense of the word since the wrapper (22) is a porous wrapping paper. The term sheath has been given its broadest reasonably definition<sup>1</sup>. A dictionary definition of a sheath as defined below is met by wrapper (22).

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<sup>1</sup> sheathe sheathe (shêth) verb, transitive

sheathed, sheath-ing, sheathes

1. To insert into or provide with a sheath.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carlos Lopez whose telephone number is (703) 605-1174. The examiner can normally be reached on Mon.-Fri. 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on (703) 308-1164. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7718 for regular communications and (703) 305-3599 for After Final communications.


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2. To retract (a claw) into a sheath.
  3. To enclose with a protective covering; encase.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.

  
STEVEN P. GRIFFIN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700

C.L  
November 15, 2002